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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/614,233 | 07/07/2003 | Soren Ebdrup | 6413.200-US | 6226 |
| 23650 | 7590 | 10/18/2004 | EXAMINER | |
| NOVO NORDISK PHARMACEUTICALS, INC 100 COLLEGE ROAD WEST PRINCETON, NJ 08540 | | | HENLEY III, RAYMOND J | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1614 | | |

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------|---------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/614,233 | EBDRUP ET AL. |
| | Examiner | Art Unit |
| | Raymond J Henley III | 1614 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on September 27, 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 and 7-66 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-3,8-30,33,34 and 36-61 is/are allowed.
- 6) Claim(s) 4,5,7,31,32,35 and 62-66 is/are rejected.
- 7) Claim(s) 4 and 7 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

CLAIMS 1-5 AND 7-66 ARE PRESENTED FOR EXAMINATION

Applicants' Amendment filed September 27, 2004 has been received and entered into the application. Accordingly, claims 1, 2, 7-10, 16, 17, 19-21 and 23-26 have been amended; claims 36-66 have been added; and claim 6 has been canceled.

In view of such amendments, the sole remaining issues are presented below. All other objections/rejections set forth in the previous Office action are withdrawn.

Claim Objections

Claims 4 and 7 are objected to because they fail to conclude with a period.

Claim Rejection - 35 USC § 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the first appearing structure of claim 4, the single boron atom represented by a combination of R¹ and R²; the "P", "Se" and "Ge" atoms of claim 5; and the fused ring system depicted in claim 7 each fail to have clear antecedent basis in claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

I Claims 31 and 32 remain rejected under 35 U.S.C. 102(a) as being anticipated by Holmes-Farley et al. (U.S. Patent Application Publication No. 2003/0064963), already of record, for the reasons of record as set forth in the previous Office action at page 7, as applied to claims 1, 2, 6, 9, 10, 14, 15, 17-32.

Applicants' amendments and arguments have been carefully considered, but fail to persuade the Examiner of error in his determination because these claims have not been amended to exclude the boron compounds of the reference.

II Claims 31 and 32 remain rejected under 35 U.S.C. 102(a) as being anticipated by Henderson et al. (U.S. Patent Application Publication No. 2002/012832), already of record, for the reasons of record as set forth in the previous Office action at page 8, as applied to claims 1, 2, 18, 19 and 21-32.

Applicants' amendments and arguments have been carefully considered, but fail to persuade the Examiner of error in his determination because these claims have not been amended to exclude the boron compounds of the reference.

Claim Rejections - 35 USC § 103

I Claims 35 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes-Farley et al., as above, and for the reasons of record as set forth in the previous Office action at page 9, as applied to claims 22, 25, 26 and 33-35.

Applicants' amendments and arguments have been carefully considered, but fail to persuade the Examiner of error in his determination because these claims have not been amended to exclude the boron compounds of the reference.

II Claims 35 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson, as above, and for the reasons of record as set forth in the previous Office action at page 10, as applied to claims 22, 25, 26 and 33-35.

Applicants' amendments and arguments have been carefully considered, but fail to persuade the Examiner of error in his determination because these claims have not been amended to exclude the boron compounds of the reference.

Allowable Subject Matter

Claims 1-3, 8-30, 33, 34 and 36-61 are in condition for allowance.

Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J Henley III whose telephone number is 571-272-0575. The examiner can normally be reached on M-F, 8:30 am to 4:00 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raymond J Henley III
Primary Examiner
Art Unit 1614

October 12, 2004